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EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/746,508

Applicant(s)

WILLIS ET AL.

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,5,7,10,11 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5, 7, 10, 11, and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5, 7, 10, 11, and 19-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Pruett et al.

Pruett et al. teaches a combination system for provisioning and maintaining telephonic network facilities in a public switched telephone network. Pruett et al. specifically teaches a Caseworker obtaining a description of a customer trouble (column 40; lines 47-49). With this information the Caseworker builds a trouble report profile which is forwarded to Dispatch (column 42; lines 51-53) where a technician is sent. Examiner notes that this relates to applicant's receiving reports or malfunctions and dispatching technicians in response to the reports.

Pruett et al. further teaches that the field technician determines any related trouble reports stored in Dispatch. The field technician closes out the Trouble Report by entering the trouble found, work done and cause descriptions (column 43; lines 41-45). Examiner notes that this represents receiving, via a communications network, information sent by the technician upon diagnosing a malfunction at a first subscriber location, wherein the information is provided in an electronic format, and identifies a cause of the malfunction underlying one of the reports of malfunction sent from the vicinity of the first subscriber location.

Pruett et al. further teaches that the reactive maintenance system is able to collate and group related reactive and proactive troubles, as well as determine whether technicians are currently working on a recently reported reactive trouble (e.g. column 53; lines 12-15). This has the additional benefit of allowing caseworkers to determine that a trouble from a customer is already being worked (e.g. column 40; lines 62-67). Examiner notes that this relates to determining, by the dispatch division (Caseworker) and based upon information sent by the technician upon diagnosing the malfunction at the first subscriber location, that a cause underlying another report, received from a location different from the first subscriber location is the same cause as the first location.

Pruett et al. also teaches information recorded by the caseworker or the field technician is automatically sent to other systems as needed. For example time and materials charges are sent to a billing function (col. 43, lines 55-57).

Pruett et al. is silent as to who receives the billing from the Billing Function.

Examiner takes Official Notice that it is old and well known for a responsible party to be billed for all costs incurred, even indirectly. As way of example, Examiner offers that in a car accident, the responsible party is billed not only for the car they hit, but also for any other damages that are incurred as a result of the accident (i.e. other cars hit, injuries etc).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the billing function of Pruett to bill the responsible party for all costs incurred as a result of their negligence including any service calls made in response to that damage. One of ordinary skill would have been motivated to modify the reference in order to recover all costs caused by the responsible party.

Response to Arguments

Applicant's arguments with respect to claims 2, 4, 5, 7, 10, 11, and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

Examiner, for the sake of clarity will address Applicant's arguments with respect to Pruett et al. Applicant asserts on page 7 of the arguments filed 1/31/05 that:

“claim 20 is directed to the situation where the technician visits the first subscriber location to find that the cause of the malfunction is somewhere else, the entity other than the first subscriber who caused the problem somewhere else is identified, and the entity is then billed for the costs associated with the technician having visited the first subscriber location.

“Pruett fails to disclose such recitations. Instead Pruett discloses that the technicians are dispatched to customer locations and that costs (time and material in Pruett) are then sent to a billing function to bill the customer, see col. 43, lines 50-62. Pruett fails to discuss the situation of where a technician visits a customer location only to find that the cause is somewhere else. Furthermore, Pruett fails to disclose that an entity, other than the customer, that is responsible for the cause is identified and that the costs associated with the technician's visit to the customer site is then billed to that entity.”

Examiner notes that Applicant makes three separate assertions in support of the argument that Pruett fails to disclose the recitations of claim 20. 1) Pruett discloses that the technicians are dispatched to customer locations and that costs (time and material in Pruett) are then sent to a billing function to **bill the customer** (noted emphasis added) see col. 43, lines 50-62; 2) Pruett fails to discuss the situation of where a technician visits a customer location only to find that the cause is somewhere else and 3) Pruett fails to disclose that an entity, other than the customer, that is responsible for the cause is identified and that the costs associated with the technician's visit to the customer site is then billed to that entity. Examiner will address each of these in order.

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1) Pruett discloses that the technicians are dispatched to customer locations and that costs (time and material in Pruett) are then sent to a billing function to **bill the customer** (noted emphasis added). Examiner respectfully disagree with the assertion that Pruett teaches that the information collected is expressly used to “bill the customer”. Examiner notes that Pruett is silent as to who is billed. As Applicant has pointed out in the arguments, companies conventionally absorb costs associated with a visit to a customer’s location, if the customer is not the cause.

Further, Pruett states that “The field technician determines any related trouble reports stored in Dispatch. The field technician or caseworker closes out the trouble report by entering the trouble found, work done and cause descriptions” (col. 43, line 40-45). As such, Pruett teaches determining a cause and storing that with information related to work done (e.g. time and materials). This information is then sent to a Billing Function. However, at this point Pruett is silent as to what is done with this information.

Examiner asserts by Applicant’s own admission, if the customer is not the cause of the malfunction, then a bill would not be sent to the customer. Therefore, Applicant improperly concludes that the costs sent to the billing function are used to bill the customer.

Examiner notes this is important because if the company were to recoup the costs associated with servicing the customer, there would be no motivation to then bill the responsible party. However, as Pruett does not specifically teach billing the customer, the Examiner can rely on Applicant’s assert conventional practice (i.e. company absorbs the costs) and thus motivation exists.

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2) Pruett fails to discuss the situation of where a technician visits a customer location only to find that the cause is somewhere else. Examiner respectfully disagrees. Pruett states on column 40, lines 62-66 that, "if the Caseworker determines that the entire cable has become defective as is currently being repaired as indicated by the Service Analysis System, the Caseworker can immediately inform the customer that the trouble is being worked on."

Examiner realizes that this section relates to informing a customer prior to sending out a technician. However, Examiner uses this passage as an illustration that system recognizes that a malfunction at a customer location could be caused by an error at a different location. Further, to determine "that the entire cable has become defective" a service call had to be received and a technician dispatched to a customer location. In other words, an initial service call used to determine that the entire cable is defective represents "the situation of where a technician visits a customer location only to find that the cause is somewhere else."

3) Pruett fails to disclose that an entity, other than the customer, that is responsible for the cause is identified and that the costs associated with the technician's visit to the customer site is then billed to that entity. Examiner once again asserts that Pruett is silent on who receives a bill from the Billing Function. As a result, Examiner agrees that Pruett fails to specifically disclose this recitation. However, Examiner specifically addresses recitation in the rejection under 37 USC 103(a) utilizing the *Graham v John Deere Co.* factual inquiries.

Based on the above issues, Examiner believes that the rejection of claims 2, 4, 5, 7, 10, 11, and 19-24 under 35 U.S.C. 103(a) as being unpatentable over Pruett et al., in this Office Action is proper.

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Applicant further states in the Arguments section of the reply submitted 1/31/05, that “should the Examiner consider taking Official Notice that billing the entity other than the customer for the costs associated with the visit to the customer location is well-known, Applicants hereby request that the Examiner provide a reference to support that position.”

Examiner notes that the Official Notice taken in this Office Action is not “that billing the entity other than the customer for the costs associated with the visit to the customer location is well-known”. Rather, that billing a responsible party for all damages they cause is old and well known.

Examiner notes that the distinction here is important. Namely, Examiner does not know whether utility companies billed responsible parties for all the costs they caused. In fact, Examiner will rely on Applicant’s statements that in fact utilities conventionally absorbed these costs. This is not the point the Examiner is trying to make.

Rather, Examiner notes that at the time the present invention was made, one of ordinary skill in the art, in possession of the Pruett reference would have reasonably known to utilize the information captured by system of Pruett (time and materials for each service call and the associated cause description, col. 43, lines 41-62) to bill a responsible party in lieu of simply absorbing these costs. One of ordinary skill in the art could have reasonably known to do this because it is old and well known in the art to charge a responsible party for all costs incurred for the damages they cause.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272 6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
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